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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,730	03/27/2001	Fritz Eisenhart	4112-4001	9719
27123	7590	07/19/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/817,730		EISENHART, FRITZ	
	<b>Examiner</b>		<b>Art Unit</b>	
	Timothy M. Harbeck		3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/27/2001</u> . <u>10/31/2001</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 because these claims are rejected to non-statutory subject matter. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment or machine, the claim is not statutory. No where in claims 1-22 is there any reference to a technological art, environment and machine and therefore claims 1-22 are rejected under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 9, 12, 16, 18, 22-27, 30, 33, 37, 39, 43-48, 51, 54, 58 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al (hereinafter Walker, US Pat No 5,884,272).

**Re Claim 1:** Walker discloses a method and system for establishing and maintaining user-controlled anonymous communications comprising

- Storing a first profile associated with a first member, a second profile associated with a second member, and a project profile associated with the first member (Column 4, lines 19-27 and Column 5, lines 11-16)
- Comparing the first profile and the second profile to identify at least one common characteristic (Column 4, lines 28-32 and also Fig 5, Ref 510)
- Permitting an exchange between the first member and the second member if the comparison identifies said at least one common characteristic (Column 5, lines 7-11)

**Re Claim 2:** Walker further discloses a method wherein the first profile and the second profile include a description segment and a search segment (Column 5, lines 11-19).

**Re Claim 3:** Walker further discloses a method wherein the description segment includes at least one public characteristic and one private characteristic (Column 4, lines 51-55). Walker reads "allowing the outside parties to retain control over the release of respective information to other parties." This means that while a member may present some information to other parties in hopes of initiating an

exchange, said member also maintains the right to withhold certain information until an exchange is finalized.

**Re Claim 4:** Walker further discloses a method wherein the search segment includes at least one required element and at least one optional element (Column 5, lines 42-51).

**Re Claim 5:** Walker further discloses a method wherein the first profile and the second profile include at least one characteristic, and wherein comparing the first profile and the second profile further comprises considering a degree of importance associated with each characteristic (Column 5, lines 43-45).

**Re Claim 6:** Walker further discloses a method wherein the first profile and the second profile further comprises displaying (Column 10, lines 49-51) a member profile list that includes the first profile and the second profile (Column 9, lines 47-54).

**Re Claim 9:** Walker further discloses a method wherein the first member and the second member accede to the exchange (Column 5 line 60-Column 6 line 23).

**Re Claim 12:** Walker further discloses a method wherein permitting the exchange further comprises automating the exchange (Column 4, lines 1-2).

Walker notes previous attempts to automate similar exchanges and search process in employment and matchmaking aspects, however the automation process could apply to any type of search or exchange process.

**Re Claim 16:** Walker further discloses a method wherein the exchange includes the first member and the second member negotiating the terms of a transaction

(Column 19, lines 19-22). In the Walker disclosure, the acts of "requesting and revealing information" are taken to be a form of negotiation.

**Re Claim 18:** Walker further discloses wherein the exchange is conducted in a secure storage area within the system that only the first entity and the second entity can access (Column 5, line 60- Column 6 line 23). Walker reads, "the present invention includes a system for facilitating an exchange of information between a first party and a second party, the system including a memory for storing at least a secure database; a communication port and a processor."

Walker further reads that both the first and second entity has to agree to allow the other entity into direct communication. In this way the two are assured that the communication is secure.

**Re Claims 22-27, 30, 33, and 37 and 39:** Further computer device facilitating technology exchange and collaboration device would have been necessary to perform previously rejected claims 1-6, 9, 12, 16 and 18 respectively and are therefore rejected using the same art and rationale.

**Re Claims 43-48, 51, 54 and 58 and 60:** Further computer readable medium would have been necessary to perform the method of previously rejected claims 1-6, 9, 12, 16 and 18 respectively and are therefore rejected using the same art and rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 19, 28, 40, 49 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Herz (US Pat No 6,029,195).

**Re Claim 7:** Walker discloses the claimed method supra except for the explicit disclosure wherein the first profile and the second profile further comprises displaying a project profile list that includes the project profile. Herz discloses a system for customized electronic identification of desirable objects wherein a digitally represented profile indicating a target objects attributes is termed a "target profile" (Column 4, lines 51-53). These target profiles are then available for viewing by members who search for certain terms or phrases that match the target profile (Figure 10, Ref 1103 and 1104 specifically). The Herz invention is directed to searching for customized electronic identification of desirable objects in a media environment, which could include searching for intellectual property licensing deals as in applicant's disclosure. It would have been obvious to someone skilled in the ordinary art at the time of invention to include the target profile viewing of Herz to the method of Walker, so that a user or member searching for a particular object can view a list of all potential profiles that fit their search terms. In this way the member can narrow their search based on certain criteria and find objects that best fit their needs. This would be beneficial because it would save time in that they would not have to sift through erroneous material and can focus their search.

**Re Claim 19:** Walker discloses the claimed method supra except for the explicit disclosure wherein the exchange is conducted in a storage area outside the system and a secure link encrypts data communications between the first entity, the second entity and the system. Herz discloses, in his abstract that a “cryptographically-based pseudonym proxy server is provided to ensure the privacy of a users target profile interest summary by giving the user control over the ability of third parties to access this summary and to identify or contact the user.” This allows for the users to communicate over a proxy server (secure link) that is protected through the use of cryptography. It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of Herz to the method of Walker to provide a user with a secure data link where they are free to communicate with appropriate parties, without having to worry about being spied upon or losing their anonymity.

**Re Claim 28 and 49:** Further computer device and computer readable medium of claims 28 and 49 respectively would have been obvious to perform the method of previously rejected claim 7 and would therefore be rejected using the same art and rationale.

**Re Claim 40 and 61:** Further computer device and computer readable medium of claims 40 and 61 respectively would have been obvious to perform the method of previously rejected claim 19 and would therefore be rejected using the same art and rationale.



Claims 8, 10, 20, 29, 31, 41, 50, 52 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Tran (US 2001/0049707 A1).

**Re Claim 8:** Walker discloses the claimed invention supra except for the explicit disclosure wherein the exchange involves an intellectual property asset. Tran discloses a system and method to enhance the procurement and trading of IP assets (Page 2, paragraphs 13-15). It would have been obvious to someone skilled in the ordinary art at the time of invention to include the intellectual property exchange method of Tran to the method of Walker to produce a cost effective way for businesses to use their intellectual property assets for financial gain. If a business can easily communicate with potential licensing partners regarding their intellectual property, they can quickly and easily achieve financial gains in the process. The use of intellectual property as a financial instrument is popular among businesses and a way to facilitate this process would be very useful.

**Re Claim 10:** Walker in view of Tran discloses the claimed method and Tran further discloses a method wherein the first member and the second member accede to a standardized non-disclosure agreement (Page 9, Paragraph 84)

**Re Claim 20:** Walker discloses the claimed method supra except for the explicit disclosure wherein accounts are created for a member of the system. Tran disclose creating accounts for members of a system (Page 9, Paragraph 81). It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of Tran to the method Walker so that each member in the system would

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have their own individual account, and the system can thus track member activities to aid in exchanges or to prevent fraudulent activity on member accounts.

**Re Claims 29 and 50:** Further computer device and computer readable medium claims 29 and 50 respectively, would have been obvious from previously rejected claim 8 above and therefore claims 29 and 50 are rejected using the same art and rationale.

**Re Claims 31 and 52:** Further computer device and computer readable medium claims 31 and 52 respectively, would have been obvious from previously rejected claim 10 above and therefore claims 31 and 52 are rejected using the same art and rationale.

**Re Claims 41 and 62:** Further computer device and computer readable medium claims 41 and 62 respectively, would have been obvious from previously rejected claim 20 above and therefore claims 41 and 62 are rejected using the same art and rationale.

Claims 11, 17, 32, 38, 53 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Takahashi et al (hereinafter Takahashi US Pat No 6,049,787).

**Re Claim 11:** Walker discloses the claimed method supra except for the explicit disclosure wherein permitting the exchange further comprises monitoring the exchange. Takahashi discloses an electronic business transaction system with means for conducting a notarization procedure wherein a business transaction is monitored by an outside party (Column 2, lines 28-46). Takahashi reads, "there is provided a method of managing statuses of transmissions," which is another way of saying that the transaction is being monitored. It would have been obvious to someone skilled in the

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ordinary art at the time of invention to include the monitoring aspect of Takahashi to the method of Walker so that there is a way to verify the transaction in case there is a disagreement later between the negotiating parties. In monitoring the transaction there would be a third party with a record of the transaction that can aid in settling any disputes.

**Re Claim 17:** Walker in view of Takahashi discloses the claimed method and Takahashi further discloses certifying the exchange. Takahashi notes in his abstract that the system “conducts a notarization process for the contents of the contract for the transaction.” Notarization is another way of saying that the transaction is certified. It would have been obvious to someone skilled in the ordinary art at the time of invention to include the certification process of Takahashi to the method of Walker so that the parties of a transaction will have a record of the completed transactions. This will help settle any disputes that may arise that are associated with said transaction.

**Re Claim 32 and 53:** Further computer device and computer readable medium claims 32 and 53 respectively would have been necessary to perform the method of previously rejected claim 11 and are therefore rejected using the same art and rationale.

**Re Claims 38 and 59:** Further computer device and computer readable medium claims 38 and 59 respectively would have been necessary to perform the method of previously rejected claim 17 and are therefore rejected using the same art and rationale.

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Claims 13-15, 34-36, and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Downes (Dictionary of Finance and Investment Terms, Barrons Educational Series Inc, 1998, pgs 165, 321, 520).

**Re Claim 13-15:** Walker discloses the claimed method supra except for the explicit disclosure wherein the exchange includes the first member and the second member acceding to a standardized due diligence agreement, a standardized right of first refusal agreement, and a standardized letter of intent. Downes teaches that these three types of agreements, due diligence (pg 165), letter of intent (pg 321), and right of first refusal (pg 520) were well known in the art at the time of invention. It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of Downes to the method of Walker because these agreements were well known in the art and would be used frequently when any type of transaction regarding a contractual agreement occurs.

**Re Claim 34-36:** Further computer device claims 34-36 respectively would have been necessary to perform the method of previously rejected claims 13-15 respectively and are therefore rejected using the same art and rationale.

**Re Claims 55-57:** Further computer readable medium claims 55-57 would have been necessary to perform the method of previously rejected claims 13-15 respectively and are therefore rejected using the same art and rationale.

Claims 21, 42 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Tran as applied to respective claims 20, 41 and 62 above, and further in view of O'neil et al (hereinafter O'neil US Pat No 5,987,440.)

**Re Claim 21:** Walker in view of Tran discloses the claimed method supra except for the explicit disclosure wherein creating the account further comprises verifying whether a potential member satisfies at least one criterion. O'neil discloses a personal information security and exchange tool wherein a members of a community must meet certain admission requirements in order to join the community (Column 2, line 12-16). It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of O'neil to the method of Walker in view of Tran so that members are grouped according to common interests, and thus potential exchange partners are initially filtered out before a member has to search for one. It would also be beneficial to do certain background checks on potential members to avoid allowing a fraudulent account to be created.

**Re Claims 42 and 63:** Further computer device and computer readable medium claims 42 and 63 respectively would have been necessary to perform the method of previously rejected claim 21 and are therefore rejected using the same art and rationale.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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